b.) Remarks

Claims 28, 29, 32-44 were previously presented. Claim 26 is currently amended. Claim 43 is currently amended to fix a typographical error. Applicant thanks the Examiner for allowing Claims 29 and 37-42.

The Patent Office has rejected Claim 26 under 35 U.S.C. 103(a) over IBM Technical Disclosure Bulletin in view of Shvartsman and Kataoka. In particular, "the examiner notes that claim 26 does not even include a recitation of "spin coating", "wet development", or "heat curing" and therefore these argument [*sic*] are not commensurate with the scope of coverage sought."

Turning now to the merits with regard to amended Claim 26, a heat curing step was added to that Claim.

With respect to the rest of the claims, Applicant submits that the Patent Office has not met the burden of establishing a prima facie case of obviousness. Consider In re Lee: " Board of Patent Appeals and Interferences improperly relied upon 'common knowledge and common sense' of person of ordinary skill in the art to find invention of patent application obvious over combination of two prior art references . . ." 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The CAFC went on to say: "In its decision on Lee's patent application, the board rejected the need for 'any specific hint or suggestion in a particular reference' to support the combination of the Northrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action." Id. at 1434. Applicant respectfully invites the Patent Office to cite column and line number from within the cited references as to where a suggestion to combine may be found.

Applicant would also like to bring to the attention of the Patent Office to the following: "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination." Carella v. Starlight Archery and Pro Line Co., 804 F.2d

135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986) (citing ACS Hosp. Syss., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed Cir. 1984).

Even if the Patent Office had created a prima facie case of obviousness, which applicant in no way concedes, Applicant rebuts. Applicant respectfully suggests that the Patent Office has used hindsight to attempt to combine 6 (and even more) references to find the present invention obvious. However, the references must be considered in their entirety. One reference that all of the rest of the Patent Office's arguments rely on is Fan, EP 0766142. Exposure and development is discussed on page 5, lines 33-59. Subsequent to development, Fan teaches that "[h]igh temperatures are not recommended because the support can shrink and distort, causing mounting and registration problems." Page 6, line 1. The temperature taught by Fan is 60 °C. One having ordinary skill in the art would not have been motivated to practice Fan with materials, like polyimides, that cure at hundreds of degrees Celsius.

Applicant believes that any combination of the cited publications does not teach or suggest the invention as now claimed. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is very much encouraged to contact the undersigned to discuss the pending Claims.

Respectfully submitted,

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